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PPLICATION NO. FILING DATE		DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,043	05/17/2001		Philip Charles Clark	713-484	3878
75	90	07/07/2003			
Lowe Hauptm		in	EXAMINER		
Gilman & Berne Suite 310	er		HARMON, CHRISTOPHER R		
1700 Diagonal l			ART UNIT	PAPER NUMBER	
Alexandria, VA 22314				3721	
				DATE MAILED: 07/07/2003	9

Please find below and/or attached an Office communication concerning this application or proceeding.

· · · · · · · · · · · · · · · · · · ·	Application No.	Applicant(s)					
Office Action Summary	09/856,043	CLARK, PHILIP CHARLES (1)					
omeericaen cumuu,	Examiner Christopher D. Harman						
The MAILING DATE of this communication ap	Christopher R Harmon pears on the cover she t with	th correspondenc address					
Period for Reply		••••• -					
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a replication in the period for reply is specified above, the maximum statutory period. - Failure to reply within the set or extended period for reply will, by statut. Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b). Status	136(a). In no event, however, may a reply ly within the statutory minimum of thirty (3 will apply and will expire SIX (6) MONTHS e, cause the application to become ABANI	or be timely filed 0) days will be considered timely. S from the mailing date of this communication. DONED (35 U.S.C. § 133).					
1) Responsive to communication(s) filed on 12	<u>June 2003</u> .						
2a)⊠ This action is FINAL . 2b)□ T	nis action is non-final.						
3) Since this application is in condition for allow							
closed in accordance with the practice under Disposition of Claims	Ex parte Quayle, 1935 C.D.	11, 453 O.G. 213.					
4)⊠ Claim(s) 2-7,14,16-18 and 22-32 is/are pending in the application.							
4a) Of the above claim(s) 22-32 is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6)⊠ Claim(s) <u>2-7,14 and 16-18</u> is/are rejected.							
7) Claim(s) is/are objected to.							
8) Claim(s) 22-32 are subject to restriction and/o	r election requirement.						
Application Papers	~-						
9) The specification is objected to by the Examine		Evaminar					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). 11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.							
If approved, corrected drawings are required in reply to this Office action.							
12) The oath or declaration is objected to by the Examiner.							
Priority under 35 U.S.C. §§ 119 and 120							
13) Acknowledgment is made of a claim for foreig	n priority under 35 U.S.C. § 1	19(a)-(d) or (f).					
a)⊠ All b)□ Some * c)□ None of:							
1. Certified copies of the priority documen	ts have been received.						
2. Certified copies of the priority documen	ts have been received in App	lication No					
Copies of the certified copies of the prical application from the International But See the attached detailed Office action for a list.	ureau (PCT Rule 17.2(a)).	•					
14) Acknowledgment is made of a claim for domest	·						
a) The translation of the foreign language pr	•						
15) Acknowledgment is made of a claim for domes							
Attachment(s)							
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)							

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DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 22-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: it is directed towards a tool with a barrel assembly including two separate portions and a resilient element inbetween.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

- 2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
 - The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- 3. Claims 2-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a displacement means, does not reasonably provide enablement for displacement means for displacing the engagement means rearwardly to thrust the piston rearwardly comprising an energy source in which energy is stored as a result of the recoil mass upon recoil. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to displace the engagement means rearwardly as a result of the stored

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energy provided by the recoil mass 14 the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 5. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Hirtl et al. (US 5,884,828).

Hirtl et al. disclose an explosively operated tool comprising housing 1, barrel assembly 4, piston 6, recoil mass/dampening device 17 for absorbing recoil, spring 23 is a part of the resetting mechanism which returns piston 6 to its original position; see column 4, lines 3-6.

Claim Rejections - 35 USC § 103

- 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2-7 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirtl et al. (US 5,884,828) in view of Jochum et al. (US 5,538,172).

Hirtl et al. do not directly disclose a engaging means for engaging the piston in a forward position and displacement means for rearwardly displacing the engagement means to thrust the piston rearwardly, however Jochum et al. teach means for moving piston to the rearwards position comprising engagement means 10; potential energy source 10 and recoil/resetting housing 8. Jochum et al. directly teach gripping means comprising balls cooperating with an inclined surface with balls 10 and inclined surface 11 for gripping piston 1 which are thrusted rearwardly and forcing piston 1 back with the recoil of housing 8.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Jochum et al. with the invention of Hirtl et al. in order to provide for a gripping means for arresting/returning the piston.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christopher R Harmon whose telephone number is 703-

308-8643. The examiner can normally be reached on Monday-Thursday from 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-305-3579

for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-

1148.

July 3, 2003

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EUGENE KIM PRIMARY EXAMINER